

### REMARKS

This is a full and timely response to the non-final Official Action mailed **December 26, 2008** (the “Office Action” or “Action”). Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

#### Claim Status:

By the forgoing amendment, the various claims have been amended. Thus, claims 1-21 and 23-32 are currently pending for further action.

#### Rejection under 35 U.S.C. § 101:

In the recent Office Action, claim 28 was rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. These claims have been carefully reviewed in light of the Examiner's comments.

While Applicant does not necessarily agree that claim 28 was directed to non-statutory subject matter, the indicated claim has been amended herein to address the issues raised by the Examiner under 35 U.S.C. § 101. Specifically, the various “means for” phrases have been replaced with the recitation of a processor. Following this amendment, claim 28 is clearly directed to statutory subject matter under 35 U.S.C. § 101, and notice to that effect is respectfully requested.

#### Prior Art:

##### Rejections under 35 U.S.C. §102(b):

- (1) In the recent Office Action, claims 1-21, and 23-32 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application Publication No. 2002/0193975 to

Zimmerman (hereinafter “Zimmerman”). For at least the following reasons, this rejection should be reconsidered and withdrawn.

Claim 1:

Claim 1 recites:

A method for assisting navigation of digital content using a tangible medium, comprising:

- receiving an instruction to access digital content corresponding to a portion of a tangible medium:
  - said medium being readable by a user-positionable input device, and
  - said digital content being accessible from a stored file;
- determining and accessing stored digital content corresponding to said input device's instantaneous position on said tangible medium; and
- enabling electronic navigation of said digital content including enabling toggling between browsing of said tangible medium and browsing of said digital content on a computer screen using said input device, said browsing of said digital content being performed using said input device or a second input device, in which said browsing of said digital content includes enabling a user to control translational or rotational movements of said digital content as directed by the user,

*in which said digital content comprises subject matter that differs from content of said tangible medium.*

(Emphasis added).

Support for the amendment to claim 1 can be found in Applicant's originally filed specification at, for example, page 1, paras. 1-2, page 6; first full paragraph, page 8, second full paragraph; and page 16, last paragraph.

In contrast, Zimmerman does not teach or suggest a method for assisting navigation of digital content using a tangible medium in which the digital content comprises subject matter that differs from content of the tangible medium.

Zimmerman teaches the following system:

The system generally comprises a probe device and a computer. The probe is manipulated over off-line media, preferably printed medium, and information is transmitted to the computer and matched to electronic media. Based upon the position of the probe over the off-line media, *corresponding multimedia data* is retrieved from storage and presented to the user. Preferably, the multimedia data and off-line media are designed so as to provide an

educational experience in which the synchronization of the probe position and output provides the visceral experience normally experienced by a user of a real tool. To simulate the real tool, *the multimedia data corresponds to the output a real tool would produce when the real tool is used to inspect the items on the off-line media.*

(Zimmerman, para. [0021]) (emphasis added).

However, Zimmerman fails to disclose that the digital content comprises subject matter that differs from content of said tangible medium. In fact, Zimmerman teaches away from claim 1 by reciting that the multimedia data corresponds to the off-line media, and the multimedia data corresponds to the output a real tool would produce . . . .” (Zimmerman, para. [0021]). In one specific example, Zimmerman discloses that “[t]he invention *matches the sampled image 706 to a reference image of the frog's eye* retrieved from storage device 102. Based on the probe 104 position, reference image, and tool selected, *a magnified view of a frog eye* 802 is presented on the computer screen 800.” (Zimmerman, para. [0081]) (emphasis added). Thus, in Zimmerman, the subject matter of the multimedia data is the same as the subject matter of the off-line media, only magnified.

However, claim 1 recites that the digital content comprises subject matter that differs from content of said tangible medium. This recitation within claim 1 is entirely outside the teachings of Zimmerman.

“A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). See M.P.E.P. § 2131. Therefore, for at least the reasons explained here, the rejection based on Zimmerman of claim 1 and its dependent claims should be reconsidered and withdrawn.

Claim 25:

Claim 25 similarly recites:

A computer-readable storage medium for assisting navigation of digital content using a tangible medium, comprising logic instructions that when executed:

- receive an instruction to retrieve digital content corresponding to a portion of a tangible medium:
- said medium being readable by a user-positionable input device; and
- said digital content being accessible from a stored file;
- determine and retrieve stored digital content corresponding to said input device's instantaneous position on said tangible medium;
- enable electronic navigation of said digital content; and
- enable toggling between browsing of said tangible medium and browsing of said digital content on a computer screen using said input device, said browsing of said digital content being performed using said input device or a second input device, in which said browsing of said digital content includes enabling a user to control translational or rotational movements of said digital content as directed by the user,

*in which said digital content comprises subject matter that differs from content of said tangible medium.*

(Emphasis added).

Support for the amendment to claim 25 can be found in Applicant's originally filed specification at, for example, page 1, paras. 1-2, page 6; first full paragraph, page 8, second full paragraph; and page 16, last paragraph.

In contrast, Zimmerman does not teach or suggest a computer-readable storage medium for assisting navigation of digital content using a tangible medium, comprising logic instructions that when executed receive an instruction to retrieve digital content corresponding to a portion of a tangible medium in which the digital content comprises subject matter that differs from content of the tangible medium.

As discussed above in favor of the patentability of claim 1, Zimmerman fails to disclose that the digital content comprises subject matter that differs from content of said tangible medium. In fact, Zimmerman teaches away from claim 25 by reciting that the subject matter of the multimedia data is the same as the subject matter of the off-line media

However, claim 25 recites that the digital content comprises subject matter that differs from content of said tangible medium. This recitation within claim 1 is entirely outside the teachings of Zimmerman.

“A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). See M.P.E.P. § 2131. Therefore, for at least the reasons explained here, the rejection based on Zimmerman of claim 25 and its dependent claims should be reconsidered and withdrawn.

Claim 28:

Claim 28 similarly recites:

A system for assisting navigation of digital content using a tangible medium, comprising:

- an interface configured to receive an instruction to access digital content corresponding to a portion of a tangible medium:
- said medium being readable by a user-positionable input device; and
- said digital content being accessible from a stored file; and
- a processor configured to:
  - determine and access stored digital content corresponding to said input device's instantaneous position on said tangible medium;
  - enable electronic navigation of said digital content; and
  - enable toggling between browsing of said tangible medium and browsing of said digital content on a computer screen using said input device, said browsing of said digital content being performed using said input device or a second input device, in which said browsing of said digital content includes enabling a user to control translational or rotational movements of said digital content as directed by the user, and

***in which said digital content comprises subject matter that differs from content of said tangible medium.***

(Emphasis added).

Support for the amendment to claim 28 can be found in Applicant's originally filed specification at, for example, page 1, paras. 1-2, page 6; first full paragraph, page 8, second full paragraph; and page 16, last paragraph.

In contrast, Zimmerman does not teach or suggest a computer-readable storage medium for assisting navigation of digital content using a tangible medium, comprising logic instructions that when executed receive an instruction to retrieve digital content corresponding to a portion of a tangible medium in which the digital content comprises subject matter that differs from content of the tangible medium.

As discussed above in favor of the patentability of claim 1, Zimmerman fails to disclose that the digital content comprises subject matter that differs from content of said tangible medium. In fact, Zimmerman teaches away from claim 25 by reciting that the subject matter of the multimedia data is the same as the subject matter of the off-line media

However, claim 28 recites that the digital content comprises subject matter that differs from content of said tangible medium. This recitation within claim 28 is entirely outside the teachings of Zimmerman.

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). See M.P.E.P. § 2131. Therefore, for at least the reasons explained here, the rejection based on Zimmerman of claim 28 should be reconsidered and withdrawn.

Claim 29:

Claim 29 recites:

A system for assisting navigation of digital content using a tangible medium, comprising:

- an interface configured to receive an instruction from an input device to access digital content corresponding to a portion of a tangible medium:

- said medium being readable by said input device; and

- said digital content being accessible from a stored file; and

- a processor configured to:

- determine and access digital content corresponding to said input device's position on said tangible medium;

- enable electronic navigation of said digital content; and

- enable toggling between browsing of said tangible medium and browsing of said digital content on a computer screen using said input device, said browsing of said digital content being performed using said input device or a second input device, in which said browsing of said digital content includes enabling a user to control translational or rotational movements of said digital content as-directed by the user, and

- in which said tangible medium is a map of an area, and said digital content is a map of a portion of said area, and*

- in which said digital content further includes additional information selected from the group consisting of roads, streets, and paths.*

(Emphasis added).

Support for the amendment to claim 29 can be found in Applicant's originally filed specification at, for example, page 1, paras. 1-2, page 6; first full paragraph, page 8, second full paragraph; and page 16, last paragraph.

In contrast, Zimmerman does not teach or suggest a system for assisting navigation of digital content using a tangible medium in which the tangible medium is a map of an area, and the digital content is a map of a portion of the area, and in which the digital content further includes additional information selected from the group consisting of roads, streets, and paths.

As discussed above, Zimmerman generally discloses the following:

The system generally comprises a probe device and a computer. The probe is manipulated over off-line media, preferably printed medium, and information is transmitted to the computer and matched to electronic media. Based upon the position of the probe over the off-line media, corresponding multimedia data is retrieved from storage and presented to the user.

(Zimmerman, para. [0021]).

However, Zimmerman fails to disclose that the tangible medium is a map of an area, and the digital content is a map of a portion of that area. This subject matter is clearly outside the teachings of Zimmerman.

“A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). See M.P.E.P. § 2131. Therefore, for at least the reasons explained here, the rejection based on Zimmerman of claim 29 should be reconsidered and withdrawn.

Claim 32:

Claim 32 recites:

A method for assisting navigation of digital content using a tangible medium, comprising:

- receiving an instruction to access digital content corresponding to a portion of a tangible medium:
  - said medium being readable by a user-positionable input device, and
  - said digital content being accessible from a stored file;
- determining and accessing stored digital content corresponding to said input device's instantaneous position on said tangible medium;
- enabling electronic navigation of said digital content, said electronic navigation of said digital content being performed using said input device or a second input device, in which said browsing of said digital content includes enabling a user to control translational or rotational movements of said digital content as directed by the user; and
- enabling use of multiple tangible media to facilitate three-dimensional navigation, and

***in which said tangible medium is a map of an area, and said digital content is a map of a portion of said area, and***

***in which said digital content further includes additional information selected from the group consisting of roads, streets, and paths.***

(Emphasis added).



Support for the amendment to claim 29 can be found in Applicant's originally filed specification at, for example, page 1, paras. 1-2, page 6; first full paragraph, page 8, second full paragraph; and page 16, last paragraph.

In contrast, Zimmerman does not teach or suggest a method for assisting navigation of digital content using a tangible medium in which the tangible medium is a map of an area, and the digital content is a map of a portion of the area, and in which the digital content further includes additional information selected from the group consisting of roads, streets, and paths.

As discussed above, Zimmerman generally discloses the following:

The system generally comprises a probe device and a computer. The probe is manipulated over off-line media, preferably printed medium, and information is transmitted to the computer and matched to electronic media. Based upon the position of the probe over the off-line media, corresponding multimedia data is retrieved from storage and presented to the user.  
(Zimmerman, para. [0021]).

However, Zimmerman fails to disclose that the tangible medium is a map of an area, and the digital content is a map of a portion of that area. This subject matter is clearly outside the teachings of Zimmerman.

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). See M.P.E.P. § 2131. Therefore, for at least the reasons explained here, the rejection based on Zimmerman of claim 32 should be reconsidered and withdrawn.

Conclusion:

In view of the foregoing arguments, all claims are believed to be in condition for allowance over the prior art of record. Therefore, this response is believed to be a complete response to the Office Action. However, Applicant reserves the right to set forth further arguments in future papers supporting the patentability of any of the claims, including the separate patentability of the dependent claims not explicitly addressed herein. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed.

The absence of a reply to a specific rejection, issue or comment in the Office Action does not signify agreement with or concession of that rejection, issue or comment. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment. Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicants expressly do not acquiesce to the taking of Official Notice, and respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.

If the Examiner has any comments or suggestions which could place this application in better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

DATE: March 23, 2009

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